

REMARKS

Status of the Claims

Claims 1-3, 5 and 6 are currently pending in the application. Claims 1-5 stand rejected. Claims 1-3 and 5 have been amended. Claim 4 has been canceled. All amendments and cancellations are made without prejudice or disclaimer. No new matter has been added by way of the present amendments. Specifically, the amendment to claim 1 is supported by the specification at, for instance, page 6, lines 1-18, particularly lines 15 and 16. The amendment of claims 2, 3 and 5 are to conform the claims more closely to US practice and are not narrowing amendments. New claim 6 is supported throughout the specification and at least by claims 1 and 5. Reconsideration is respectfully requested.

Objections to the Title of the Invention

The Examiner states that the Title of the Invention is not descriptive. (*See*, Office Action of May 25, 2007, at page 2, after, "Office Action"). Although Applicants disagree, to expedite prosecution, the Title of the Invention has been amended without prejudice or disclaimer to recite, "Chalcone Compound." No new matter is entered into the specification by way of this amendment. Support for this amendment may be found throughout the application, for instance at page 1, line 6. Applicants believe this Title is descriptive of the disclosed invention.

Reconsideration and withdrawal of the objection to the Title of the Invention are respectfully requested.

Objections to the Abstract

The Examiner objects to the Abstract of the invention for reciting the term “novel.” (*Id.*). Although Applicants believe the disclosed invention is novel, to expedite prosecution, the Abstract has been amended without prejudice or disclaimer to remove the term “novel.”

Reconsideration and withdrawal of the objection to the abstract are respectfully requested.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-5 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. (*See*, Office Action, at pages 2-3 and page 7). Claim 4 has been canceled without prejudice or disclaimer, thus obviating the rejection of claim 4. Applicants traverse the rejection as to the remaining claims as set forth below.

Regarding claim 1, the Examiner states the subject matter encompassed is indefinite because claim 1 recites the term “derivative thereof.” The Examiner states that the derivatives that may be encompassed by this term are not well defined. Claims 2, 4 and 5 recite the term “characterized.” The Examiner states that this term is indefinite because it is uncertain whether “characterized” is open or closed language. Claims 2-5 are further rejected as being indefinite for being directed to diseases sensitive to the compound of formula I. The Examiner states that it requires undue experimentation to determine which of all known diseases may be encompassed by such language.

Although Applicants do not agree that claim 1 is indefinite, to expedite prosecution, claim 1 has been amended without prejudice or disclaimer to remove the term "derivatives thereof" and replace it with the phrase, "an ester, ether or glycoside prodrug thereof." This phrase is supported in the specification at least at page 6, lines 1-18, particularly lines 15 and 16.

Furthermore, the term "characterized" has been removed from claims 2 and 5 without prejudice or disclaimer.

Additionally, claim 2 has been amended without prejudice or disclaimer to recite, "A therapeutic agent, wherein the agent comprises the compound according to claim 1 as an effective ingredient."

Claim 3 has been amended without prejudice or disclaimer to recite, "A method of protecting neurons, suppressing nitrogen monoxide (NO) production, inhibiting aldose reductase or suppressing interleukin production, wherein said method comprises: administering an effective amount of the therapeutic agent according to claim 2 to a subject in need thereof."

Claim 5 has been amended without prejudice or disclaimer to recite, "A food, beverage or feed, wherein the food, beverage or feed comprises the compound as defined in claim 1."

New claim 6 does not recite any of the terms or phrases mentioned by the Examiner as being the basis of an indefiniteness rejection.

Applicants believe the aforementioned amendments fully address the Examiner's basis for the rejections under 35 U.S.C. § 112, second paragraph. Therefore, reconsideration and withdrawal of the indefiniteness rejection of claims 1-3 and 5 are respectfully requested.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 2-5 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. (*See*, Office Action, at page 3). Claim 4 has been cancelled without prejudice or disclaimer, thus obviating the rejection of claim 4. Applicants traverse the rejection as to the remaining claims as set forth below.

The Examiner states that the specification fails to provide sufficient disclosure to enable one of ordinary skill in the art to practice prevention of various diseases recited and/or use of the compositions as prophylactic agents. The Examiner provides various support for this contention at pages 4-7 of the Office Action.

Although Applicants do not agree that the claims lack enablement support in the specification, to expedite prosecution, the claims have been amended without prejudice or disclaimer to remove from the claims the terms “prophylactic” and “prevention” as suggested by the Examiner. Furthermore, the phrase, “diseases sensitive to the compound” (according to claim 1) has also been removed from the claims without prejudice or disclaimer. New claim 6 also does not recite these terms.

Reconsideration and withdrawal of the enablement rejection of claims 2, 3 and 5 are respectfully requested.

Rejections Under the Obviousness-Type Double Patenting Doctrine

Claims 4 and 5 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable by co-pending U.S. Patent Application Serial No. 10/529,860. (*See*, Office Action, at page 8). Claim 4 has been canceled without prejudice or disclaimer, thus obviating the provisional rejection as to claim 4. As to claim 5, Applicants traverse.

Applicants note that both applications are pending and that amendments to the present claims have been entered. Thus, while the applications are still in prosecution and claims are being amended in both applications, it cannot be determined whether the presently claimed invention is obvious in light of co-pending U.S. Patent Application Serial No. 10/529,860. Applicants further assert that the presently claimed invention, at least as amended, is not obvious in light of co-pending U.S. Patent Application Serial No. 10/529,860.

Thus, reconsideration and withdrawal of the provisional obviousness-type double patenting rejection of claim 5 are respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dimmock et al., *Curr. Med. Chem.*, 6:1125-1149, 1999 (hereinafter, "Dimmock et al.") and Parmar et al., *Bioorg. & Med. Chem.*, 5(8):1609-1619, 1997 (hereinafter, "Parmar et al."). (*See*, Office Action, at page 9). Claim 4 has been canceled without prejudice or disclaimer, thus obviating the rejection as to claim 4. Applicants traverse the rejection as to the remaining claims as after set forth below.

The Examiner admits that neither Dimmock et al. nor Parmar et al. disclose the specific compounds recited in claim 1. That is, Dimmock et al. do not disclose that R_1 and R_2 may be as defined in claim 1. However, the Examiner states that Dimmock et al. disclose that the rings on the disclosed compounds may be substituted by "other groups." The Examiner states that these "other groups" disclosed at the last two sentences on page 1126 of Dimmock et al. are within the scope of claim 1 because claim 1 recites "derivatives thereof."

Regarding Parmar et al., the Examiner states that the structures disclosed in Parmar et al. differ from those recited in claim 1 because Parmar et al. do not disclose a hydroxyl group at position 4 of the phenyl ring of the prenyl substituent. The Examiner states further that Parmar et al. disclose other derivatives that may be obtained using common organic synthesis techniques. The Examiner states that these other derivatives disclosed at page 1612 of Parmar et al., right column, are encompassed by the "derivatives thereof" recited in claim 1.

However, as already discussed, above, claim 1 has been amended without prejudice or disclaimer to remove the phrase "derivatives thereof." Claim 1 now recites, in part, "an ester, ether or glycoside prodrug thereof." This phrase is supported in the specification at least at page 6, lines 1-18, particularly lines 15 and 16.

Neither the disclosure of Dimmock et al., nor the disclosure of Parmar et al. disclose or suggest the specific structures recited in claim 1, as admitted by the Examiner, and neither disclosures, either considered in combination or separately, disclose or suggest the specific esters, ethers or glycosides of the structures recited in claim 1. Thus, claim 1 cannot be obvious in light of the disclosures of the cited references.

Since no specific reasoning is provided for the rejection of dependent claims 2, 3 and 5, dependent claims 2, 3, 5 and new dependent claim 6 are believed to also not be obvious in light of the cited references because, *inter alia*, they depend from a non-obvious base claim, amended claim 1.

Reconsideration and withdrawal of the obviousness rejection of claims 1-3 and 5 are respectfully requested.

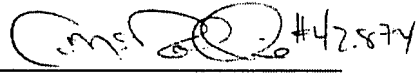
CONCLUSION

If the Examiner has any questions or comments, please contact Thomas J. Siepmann, Ph.D., Registration No 57,374, at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

for By  #42,874

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Attachment: Clean copy of Abstract

